

**REMARKS**

Claims 1 and 11 have been revised to use alternative language to encompass the same intended subject matter. For example, the claims now expressly recite the inherent feature of the catalyst as containing zinc and as being a zinc dicarboxylic acid ester catalyst, which is supported at least on page 10, last sentence, of the application as filed. No change in claim scope is intended or believed to have occurred, and no new issue requiring search or consideration is presented.

No new matter has been introduced, and entry of the above revised claims is respectfully requested.

**Alleged Rejection Under 35 USC § 102(b)**

Claims 1-7 and 9-11 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent 5,605,981 (the '981 patent). Applicants have carefully reviewed the statement of the rejection and respectfully traverse. Reconsideration and withdrawal of this rejection are respectfully requested.

Based on Applicants' review of the instant rejection, Applicants believe it to be based at least in part on the assertion that the claimed methods encompass "no process step, other than mixing" of components. The rejection further asserts that the "mixing" of the same components is reported by the '981 patent, albeit for different reasons. Applicants respectfully disagree.

As an initial matter, Applicants respectfully point out that as previously presented, none of the claims only encompassed "mixing" of components. To the contrary, previously presented claims 1 and 11 included at least an express act of "separating" while previously presented claim 11 included the express act of "copolymerizing." Moreover, and with respect to the acts of "mixing" in the claims, Applicants point out that those acts permit a chemical reaction to proceed from reactants to a zinc containing catalyst as a product. Therefore, the claims are not merely directed to the combination of components without any reactivity between them.

To emphasize the distinctiveness of the claimed invention over the cited document, claims 1 and 11 have been revised to expressly include the act of "precipitating" in addition to the "separating" already recited in the claims. Claim 11 has also been revised to use alternative language to express the act of "copolymerizing." Specifically, the claim now recites "combining ... under copolymerization conditions" which refers to specific reaction conditions known to the

skilled person in the relevant field. Additionally, the inherent presence of zinc in the catalyst featured in the claims has now been made explicit.

Along with the revised claims, Applicants point out that the '981 patent does not teach or suggest any act of "precipitating" material. Indeed, the term "precipitate," or variations thereof, is not even used in the document.

Additionally, the '981 patent does not teach or suggest any zinc containing dicarboxylic acid ester catalyst as featured in the claims. To the contrary, and as acknowledged in the statement of the rejection, the only zinc containing catalyst is one used for "ring opening copolymerization" where none of the reported catalysts is a dicarboxylic acid ester catalyst. Additionally, the "zinc stearate" mentioned in the patent is an additive to a mixture of components and not a zinc dicarboxylic acid ester catalyst as generated (in claims 1-7 and 9-11) or used (in claim 11) by the claimed methods.

In light of the factual differences between the claimed methods and those reported in the cited document, Applicants respectfully submit that no case of anticipation is present and this rejection may be properly withdrawn.

#### **Alleged Rejection Under 35 USC § 103(a)**

Claims 1-7 and 9-11 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the '981 patent (as cited above) and Li-Chen et al. (1987). Applicants have carefully reviewed the statement of the rejection and respectfully traverse. Reconsideration and withdrawal of this rejection are respectfully requested.

The instant rejection appears to be based on the assertion that it would be obvious to use the Li-Chen et al. copolymerization of carbon dioxide and propylene oxide in the reactions of the '981 patent.

Applicants respectfully traverse because Li-Chen et al. fail to remedy the deficiencies of the '981 patent as identified above. For example, there is no teaching or suggestion by Li-Chen et al. of a zinc dicarboxylic acid ester catalyst.

In light of the deficiencies, no case of obviousness is present, and this rejection may be properly withdrawn.

**Conclusion**

It is believed that the application is now in condition for allowance. Applicants request the Examiner to issue a notice of Allowance in due course. The Examiner is encouraged to contact the undersigned to further the prosecution of the present invention.

The Commissioner is authorized to charge JHK Law's Deposit Account No. **502486** for any fees required under 37 CFR §§ 1.16 and 1.17 and to credit any overpayment to said Deposit Account No. **502486**.

Respectfully submitted,

**JHK Law**

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By: /Joseph Hyosuk Kim/  
Joseph Hyosuk Kim, Ph.D.  
Reg. No. 41,425

P.O. Box 1078  
La Canada, CA 91012-1078  
(818) 249-8177 - direct  
(818) 249-8277 - fax